



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,357	04/05/2001	John Black	9456.5	3915

21999 7590 04/06/2005

KIRTON AND MCCONKIE
1800 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
P O BOX 45120
SALT LAKE CITY, UT 84145-0120

EXAMINER

BROOKS, MATTHEW L

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,357

Applicant(s)

BLACK, JOHN

Examiner

Matthew L. Brooks

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☒ Claim(s) 5, 12 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/5/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. **Claims 5 and 12** is objected to because of the following informalities: It is unclear to the Examiner the meaning of "selected third parties" and I am under the impression that it could be any third party who wishes to purchase sports-related merchandise. Appropriate correction is required.
2. **Claim 28** is objected to because of the following informalities: "system method" must be a typo and Examiner considers Applicant's intended meaning in alignment with the previous claims to be "system". However, appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. **Claims 18 and 25** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification is silent as to how Applicant intends to rank boxers "based on ability" and Examiner is uncertain how the method or

Art Unit: 3629

system would do so. However, for purposes of 102 and 103, I presumed applicant ranked on an order such as "win/loss" record.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 7 and 14** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that they fail to point out what is included or excluded by the claim language. This claim is an omnibus type claim. "Data location" is indefinite as used in the context of the claim and Examiner is unsure of what the applicant intends to include or exclude by the claim language.

7. **Claims 5 and 12** are rejected under 35 U.S.C. 112, second paragraph, in that they fail to further limit the claim, which is a method of "coordinating a sporting event/boxing match". Examiner is sure that the selling of sports merchandise has not much to do with coordinating a boxing match.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 1-3, 6-11, 13, 14, and 22-28** are rejected under 35 U.S.C. 102(b) as being anticipated by Sutcliffe et al. (6,249,282).

As per **Claim 1, 8, and 22**.

Art Unit: 3629

Sutcliffe discloses:

A method and system for coordinating a competitive sporting event comprising the steps of:

receiving information from at least one user regarding said user's willingness to consider participation in a potential sporting event; (Column 3, 4-10). Sutcliffe clearly discloses receiving information from at least one user regarding user's willingness to participate in many types of events including gender-neutral events and sporting events (Column 4, 40-42 and Column 10, 62-67 through Column 11, 1-4);

organizing said information received from said at least one user into an electronically searchable format (Column 5, 8-12);

providing access to said information organized into an electronically searchable format to said user and third parties (Column 7, 61-64).

10. With respect to **Claim 2 and 9**:

Sutcliffe discloses:

the step of proposing a contest in a sporting event between at least a first user and a second user (Column 6, 9-11 and Column 2, 65-68 through Column 3, 1 and Column 3, 15-18 and Column 11, 1-3) Sutcliffe uses the information to match one user to another and will even automatically search and match users whom are compatible to one another and notify user(s) (Column 8, 5-10) .

11. With respect to **Claim 3 and 10**:

Sutcliffe discloses:

the step of organizing a sporting event based on said information through the use of a web site and a wide area network (Column 11, 1-3).

12. With respect to Claim **6, 13 and 26**:

Sutcliffe discloses:

the step of enabling a first sports participant to challenge a second sports participant in a sporting event using the information organized therein (Column 2, 65-68 through Column 3, 1) match data allows one user to establish contact with at least another user and inherently can challenge said user with in the context of the contact. Also, combined with searching for the activity partner the participants must meet in some location to carry out the activity (Column 10, 62-68 through Column 11, 1-3).

13. With respect to **Claims 7 and 14**:

Sutcliffe discloses:

the step of providing each of said at least one users with a data location accessible by said user and a portion of which is also accessible by selected of said third parties (Column 4, 48-56); Examiner considers properly authorized users to be the equivalent of select third parties.

14. With respect to **Claims 11 and 24**: the means for enabling a sports participant or boxer to locate an agent among said information; Sutcliffe discloses that a user may conduct a search based upon certain criteria data (2, 30-37). Sutcliffe does not disclose "per se" using the data to find an agent. However, using Sutcliffe system to find an "agent" could certainly be done simply by requesting the characteristic data of "agent" (Column 7, 60-63).

Art Unit: 3629

15. With respect to **Claim 23**: the means for selecting a location and opponent to box from among other participating boxers found within the information organized into the electronically searchable format. This is nothing more than after contacting a user choosing a place to meet up or box and Sutcliffe system certainly discloses this capability (Column 3, 15-20).

16. With respect to **Claim 25**: the means for ranking boxers based on ability to enable a participating boxer to select an opponent of similar or advanced ability; Sutcliffe discloses presenting requested information to a user in an ordered manner and examiner considers this to be equivalent of ranking (Column 2, 24-27).

17. With respect to **Claim 27**: Sutcliffe discloses a means to search said information via a wide area computer network (Column 4, 17-31).

18. With respect to **Claim 28**: Sutcliffe discloses a means for establishing at least one web page for at least one of said participating boxers, which web page is viewable by selected of said third parties. Sutcliffe uses the system to provide personal ads in with many components (Column 3, 65-67 through Column 4, 1-5) and presents the personal adds over the internet (Column 4, 18-22) through a plurality of web sites (Column 4, 64-67).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3629

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. With respect to Claims **4 and 17**: are unpatentable in view of Sutcliffe. As to the step for enabling a sports participant or boxer to locate an agent among said information; Sutcliffe discloses that a user may conduct a search based upon certain criteria data (2, 30-37). Sutcliffe does not disclose "per se" using the data to find an agent. However, modifying the terms such as "sports participant and user" to "boxer and agent" is nothing more than modifying the **terminology** (See Applicant's Specification, Page 27, 3rd Paragraph).

Furthermore, it would be obvious to one of ordinary skill in the art at the time of the invention that if the boxer wanted to locate an agent using the method disclosed in Sutcliffe to find an "agent" she certainly could do so (Column 7, 60-63).

21. With respect to Claims **5 and 12**:

the step or means for providing electronic commerce for selected third parties seeking to purchase sports-related merchandise associated with a selected sports participant, is old and well known with in the art and therefore would be obvious.

22. With respect to Claim **15**:

A method for coordinating a competitive boxing match comprising the steps of:
receiving information from at least one boxer regarding said boxer's willingness to consider participating in a potential competitive boxing match;

organizing said information received from said at least one boxer into an electronically searchable format;

providing access to said information organized into an electronically searchable

format to said boxer, to other boxers, and to third parties.

Sutcliffe discloses all of the functions with in Claim 15 except for the underlined terms. However, Applicant's own specification refers to the terms "boxer" versus "tennis player" versus "user" and "boxing match" versus "tennis game" versus "... event" as simply a matter of **terminology** (See Applicant specification, page 27, 3rd full paragraph) and it would be obvious to modify Sutcliffe to perform Applicant's steps concerning boxers because Sutcliffe terminology is user. Examiner sees this as nothing more than an obvious substitute.

Furthermore in further view of "angelfire.com", which in and of itself could be used to establish a 102 rejection, because "angelfire.com" discloses receiving information of boxers willingness to participate in a boxing match, organizes it into an electronically searchable format, provides access to the info in an electronically searchable format and even has the title of the web page "MATCHMAKING".

23. With respect to **Claim 16**:

the step of selecting a location and opponent to box from among other participating boxers found within the information organized into the electronically searchable format. Sutcliffe allows users to establish contact (Column 3, 15-20) and in view of "anglefire" which allows boxers to select a boxing match and location it would be obvious to one skilled in the art at the time of the invention to use Sutcliffe to select a location. Furthermore, boxing matches inherently must have a location and to propose a match or challenge a boxer to a match would be impossible with out one.

Art Unit: 3629

24. With respect to **Claim 18**:

the step of ranking boxers based on ability to enable a participating boxer to select an opponent of similar or advanced ability; Sutcliffe discloses presenting requested information to a user in an ordered manner and examiner considers this to be equivalent of ranking (Column 2, 24-27) in further view of "angelfire" and the fact that Applicant's own specification refers to the terms "boxer" versus "tennis player" versus "user" is simply a matter of **terminology** (See Applicant specification, page 27, 3rd full paragraph) it would be obvious to modify Sutcliffe to present boxers in an ordered manner.

25. With respect to **Claim 19**:

the step of enabling a first sports participant to challenge a second sports participant in a sporting event using the information organized therein (Sutcliffe: Column 2, 65-68 through Column 3, 1) match data allows one user to establish contact with at least another user and although Sutcliffe does not disclose boxer in further view of "angelfire.com" it would be obvious to use Sutcliffe to challenge said boxer with this contact.

26. With respect to **Claim 20**:

enabling said information organized into an electronically searchable format to be accessed via a wide area computer network (Sutcliffe: Column 4, 17-31) in further view of "angelfire.com" and the fact that Applicant's own specification refers to the terms "boxer" versus "tennis player" versus "user" is simply a matter of **terminology** (See

Art Unit: 3629

Applicant specification, page 27, 3rd full paragraph) it would be obvious to present boxer information via a wide area computer network.

27. With respect to **Claim 21**:

Sutcliffe discloses the step of establishing at least one web page for at least one of said participating boxers, which web page is viewable by selected of said third parties. Sutcliffe uses the system to provide personal ads in with many components (Column 3, 65-67 through Column 4, 1-5) and presents the personal adds over the internet (Column 4, 18-22) through a plurality of web sites (Column 4, 64-67). Sutcliffe does not disclose "boxer".

In further view of "angelfire.com", which in and of itself could be used to establish a 102 rejection, because "angelfire.com" discloses receiving information of boxers willingness to participate in a boxing match, organizes it into an electronically searchable format, provides access to the info in an electronically searchable format and also provides links which will take a directed user to said boxer's website.

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include Sutcliffe et al.(6,052,122) and Collins, Gregg (5,963,951).

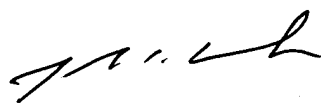
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (703) 605-1202. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

Art Unit: 3629

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-605-1202. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLB



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600